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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,183	02/13/2001	Stephan P. Capps	MCS-058-00	7809
27662	7590	05/20/2005	EXAMINER	
LYON & HARR, LLP 300 ESPLANADE DRIVE, SUITE 800 OXNARD, CA 93036			CHEN, CHONGSHAN	
			ART UNIT	PAPER NUMBER
			2162	

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/681,183

Applicant(s)

CAPPS, STEPHAN P.

Examiner

Chongshan Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 4-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### DETAILED ACTION

1. This action is responsive to communications filed on 25 February 2005. Claims 1, 2, and 4-50 are pending in this Office Action.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4-6, 9, 11, 13, 14, 20, 24-27, 29, 35-38, 40, 41 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smiga et al. ("Smiga", US 6,421,678) in view of Thorner et al. ("Thorner", US 6,463,443).

As per claim 1, Smiga teaches a system for automatically alerting a user to available information comprising:

parsing an electronic document, said electronic documents including any of a word processor document, an Internet Web page, a spreadsheet, and any textual and graphical data rendered on a display device, to identify data representing any person (Smiga, Fig. 2, element 3000, parser, col. 5, line 63 – col. 6, line 13, col. 23, lines 17-23, please note the claimed electronic documents including any of ... textual data, Smiga teaches parsing text data);

identify at least one person represented by the identified data (Smiga, col. 23, lines 17-23).

Smiga does not explicitly disclose retrieving information relating to each identified person from at least one electronic database; notifying the user that the retrieved information is available; and using at least a portion of the retrieved information relating to one or more of the identified persons to provide at least one electronic interface for initiating communication with those identified persons.

Thorner teaches retrieving information relating to each identified person from at least one electronic database; notifying the user that the retrieved information is available (Thorner, col. 4, lines 40-61, "A person A at the computer 1 states that he/she intends to make a database search for a person and/or family, and/or organization related information, below called subject information ..."); and

using at least a portion of the retrieved information relating to one or more of the identified persons to provide at least one electronic interface for initiating communication with those identified persons (Thorner, col. 4, lines 62-67, "Automatic connection to a inquired person/family/company", col. 7, lines 43-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Smiga by incorporating the means of searching and communicating as disclosed by Thorner (Thorner, col. 4, lines 40-67, col. 7, lines 43-55). The motivation being to find additional information associated with the identified person such as email address so that the user can contact the identified person.

As per claim 4, Smiga and Thorner teach all the claimed subject matters as discussed in claim 1, and further teach wherein the at least one electronic interface for initiating communication with one or more of the identified persons includes any of an email address, an

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instant message, a telephone number, a fax number, and an Internet address for communicating with the identified person (Thorner, col. 7, lines 42-55).

As per claim 5, Smiga and Thorner teach all the claimed subject matters as discussed in claim 1, and further teach wherein parsing an electronic document to identify data representing any person comprises identifying textual data associated with any person (Smiga, col. 5, line 63 – col. 6, line 47).

As per claim 6, Smiga and Thorner teach all the claimed subject matters as discussed in claim 5, and further teach wherein the textual data associated with any person includes any of: a name, an email address, a telephone number, a fax number, and a social security number (Smiga, col. 5, line 63 – col. 6, line 47).

As per claim 9, Smiga and Thorner teach all the claimed subject matters as discussed in claim 1, and further teach wherein identifying at least one person represented by the identified data comprises comparing the identified data to information in at least one electronic database to identify each person associated with the identified data (Thorner, col. 4, lines 40-67).

As per claim 11, Smiga and Thorner teach all the claimed subject matters as discussed in claim 1, and further teach wherein notifying the user that the retrieved information is available comprises automatically providing a visible alert when the information is retrieved from the at least one electronic database (Thorner, col. 8, lines 15-20).

As per claim 13, Smiga and Thorner teach all the claimed subject matters as discussed in claim 11, and further teach the visible alert comprises dynamically modifying the appearance of the electronic document (Smiga, Fig. 3, col. 6, lines 1-48, shadow region).

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As per claim 14, Smiga and Thorner teach all the claimed subject matters as discussed in claim 11, and further teach wherein dynamically modifying the appearance of the electronic document comprises changing the appearance of the identified data (Smiga, Fig. 3, col. 6, lines 1-48, shadow region).

As per claim 20, Smiga and Thorner teach all the claimed subject matters as discussed in claim 1, and further teach a graphical user interface for interacting with the retrieved information (Thorner, col. 4, lines 62-67).

As per claim 24, Smiga teaches a computer-implemented process for automatically providing information on a computer display device, comprising:

scanning electronic data being rendered on the computer display device to identify information within the electronic data that represents at least one person (Smiga, Fig. 2, col. 5, line 63 – col. 6, line 13, col. 23, lines 17-23, the parser scans/parses the display input to identify a person);

identifying each person represented by the identified information (Smiga, col. 23, lines 17-23).

Smiga does not explicitly disclose retrieving information relating to each identified person from at least one electronic database; providing an alert for indicating that the retrieved information is available; using at least a portion of the retrieved information relating to one or more of the identified persons to provide a user interface for initiating communication with those identified persons via at least one electronic communication access point.

Thorner teaches retrieving information relating to each identified person from at least one electronic database; providing an alert for indicating that the retrieved information is available

(Thorner, col. 4, lines 40-61, "A person A at the computer 1 states that he/she intends to make a database search for a person and/or family, and/or organization related information, below called subject information ..."); and

using at least a portion of the retrieved information relating to one or more of the identified persons to provide a user interface for initiating communication with those identified persons via at least one electronic communication access point (Thorner, col. 4, lines 62-67, "Automatic connection to a inquired person/family/company", col. 7, lines 43-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Smiga by incorporating the means of searching and communicating as disclosed by Thorner (Thorner, col. 4, lines 40-67, col. 7, lines 43-55). The motivation being to find additional information associated with the identified person such as email address so that the user can contact the identified person.

As per claim 25, Smiga and Thorner teach all the claimed subject matters as discussed in claim 24, and further teach the user interface provides a user access for viewing the retrieved information (Smiga, Fig. 8).

Claims 26 and 27 are rejected on grounds corresponding to the reasons given above for claims 13 and 14.

As per claim 29, Smiga and Thorner teach all the claimed subject matters as discussed in claim 26, and further teach automatically changing the appearance of graphical information representing the identified information (Smiga, Fig. 3, col. 6, lines 1-148, shadow region).

Claims 35-38, 40, 41 and 50 are rejected on grounds corresponding to the reasons given above for claims 1, 4-6, 9, 11, 13, 14 and 20.

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4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smiga et al. ("Smiga", US 6,421,678) in view of Thorner et al. ("Thorner", US 6,463,443) and further in view of Srinivasan (US 6,717,936).

As per claim 2, Smiga and Thorner teach all the claimed subject matters as discussed in claim 1, and further teach providing electronic interface (email) for initiating communication with the person. However, neither Smiga nor Thorner explicitly discloses the at least one electronic interface for initiating communication is displayed to a user as an icon representing at least one communication access point related to the retrieved information. Srinivasan teaches the at least one electronic interface for initiating communication is displayed to a user as an icon representing at least one communication access point related to the retrieved information (Srinivasan, col. 6, lines 62-64). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Smiga and Thorner's combined system by incorporating the icon as disclosed by Srinivasan (Srinivasan, col. 6, lines 62-64). The motivation being to display the communication program in a conventional practice such as an icon on the display for the user to initiate communication with a person.

5. Claims 7, 8 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smiga et al. ("Smiga", US 6,421,678) in view of Thorner et al. ("Thorner", US 6,463,443) and further in view of Dimitrova (US 6,363,380).

As per claim 7, Smiga and Thorner teach all the claimed subject matters as discussed in claim 1, except for explicitly disclosing parsing an electronic document to identify data representing any person comprises identifying graphical data associated with any person. Dimitrova teaches parsing graphical data to identify person (Dimitrova, col. 12, lines 1-7).



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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Smiga and Thorner's combined system by incorporating a graphical parser as disclosed by Dimitrova (Dimitrova, col. 12, lines 1-7). The motivation being to enable the system to identify not only textual data but also graphical data associated with a person.

As per claim 8, Smiga, Thorner and Dimitrova teach all the claimed subject matters as discussed in claim 7, and further teach the graphical data associated with any person includes any image for representing at least one person (Dimitrova, col. 12, lines 1-7).

Claim 39 is rejected on grounds corresponding to the reasons given above for claims 7 and 8.

6. Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smiga et al. ("Smiga", US 6,421,678) in view of Thorner et al. ("Thorner", US 6,463,443) and further in view of Sorensen (US 6,628,729).

As per claim 10, Smiga and Thorner teach all the claimed subject matters as discussed in claim 1, except for explicitly disclosing wherein notifying the user that the retrieved information is available comprises automatically providing an audible alert when the information is retrieved from the at least one electronic database. Sorensen teaches providing an audible alert when information is retrieved (Sorensen, col. 3, lines 27-30). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Smiga and Thorner's combined system by incorporating an audio alert as disclosed by Sorensen (Sorensen, col. 3, lines 27-30). The motivation being to promptly reminder the user that information is available.

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Claim 12 is rejected on grounds corresponding to the reasons given above for claims 10 and 11.

7. Claims 15, 28, 30 and 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smiga et al. ("Smiga", US 6,421,678) in view of Thorner et al. ("Thorner", US 6,463,443) and further in view of Yamakita (US 6,272,490).

As per claim 15, Smiga and Thorner teach all the claimed subject matters as discussed in claim 14, except for explicitly disclosing wherein dynamically modifying the appearance of the electronic document further comprises automatically associating at least one hyperlink with the identified data. Yamakita teaches associating at least one hyperlink with the identified data (Yamakita, col. 1, lines 35-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Smiga and Thorner's combined system by associating a hyperlink with the identified data as disclosed by Yamakita (Yamakita, col. 1, lines 35-67). The motivation being to enable the user to retrieve information by click the hyperlink.

Claims 28, 30 and 42-45 are rejected on grounds corresponding to the reasons given above for claim 15.

8. Claims 16-19, 21-23, 31-34 and 46-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smiga et al. ("Smiga", US 6,421,678) in view of Thorner et al. ("Thorner", US 6,463,443) and further in view of Appelman et al. ("Appelman", US 6,539,421).

As per claim 16, Smiga and Thorner teach all the claimed subject matters as discussed in claim 11, except for explicitly disclosing the visible alert comprises dynamically adding at least one presence indicator to the electronic document. However, Smiga and Thorner teach using

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electronic communication (email) to communicate with a person. Appelman teaches using instant messaging, which is a type of electronic communication system, to communicate with a person (Appelman, col. 4, lines 24-30). Instant messaging system provides a visible alert that adds presence indicator associated with the person (Appelman, col. 5, lines 52-55). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Smiga and Thorner's combined system by using a instant messaging system with presence indicator as disclosed by Appelman to communicate with the identified person. The motivation being to provide a faster and efficient way to communicate with the identified person because with email system, the message sender will never know when the person will read the email and reply to the email message. However, instant message system tells the user whether the person is online or not, and allows the user to communicate with the person right away in real time.

As per claim 17, Smiga, Thorner, and Appelman teach all the claimed subject matters as discussed in claim 16, and further teach the instant message system provides online status (Appelman, col. 4, lines 24-30, col. 5, lines 52-55), which automatically determining an online status for each identified person by querying at least one messaging account server for each identified person.

As per claim 18, Smiga, Thorner and Appelman teach all the claimed subject matters as discussed in claim 17, and further teach each presence indicator graphically represents the online status of each identified person (Appelman, col. 5, lines 52-55).

As per claim 19, Smiga, Thorner and Appelman teach all the claimed subject matters as discussed in claim 18, and further teach using instant messaging system to communicate with the

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person and display the online status of the person (Appelman, col. 4, lines 24-30, col. 5, lines 52-55), which includes the graphical representation of the online status of each identified person is automatically updated by re-querying the at least one messaging account server for each identified person.

As per claim 21, Smiga and Thorner teach all the claimed subject matters as discussed in claim 20, except for explicitly disclosing the graphical user interface comprises at least one pop-up window for displaying the retrieved information for each identified person. Appelman teaches the graphical user interface comprises at least one pop-up window for displaying the retrieved information for each identified person (Appelman, Fig. 28-29). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Smiga and Thorner's combined system by incorporating the use of pop-up window as disclosed by Appelman (Appelman, Fig. 28-29). The motivation being to attract the user attention by using a pop-up window.

As per claim 22, Smiga, Thorner and Appelman teach all the claimed subject matters as discussed in claim 20, and further teach the graphical user interface comprises at least one context-sensitive menu for interacting with the retrieved information for each identified person (Appelman, Fig. 28-29).

As per claim 23, Smiga, Thorner and Appelman teach all the claimed subject matters as discussed in claim 20, and further teach the graphical user interface comprises at least one hyperlink for accessing the retrieved information for each identified person via a computer pointing device (Appelman, Fig. 5).

Claims 31-34 and 46-49 are rejected on grounds corresponding to the reasons given above for claims 16-19 and 21-23.

*Response to Arguments*

9. Applicant's arguments filed 25 February 2005 have been fully considered but they are not persuasive.

10. As per applicant's arguments regarding the references do not teach parsing documents to identify data representing any person have been considered but are not persuasive. Please note the claim recites "parsing an electronic document, said electronic documents including any of ... textual and graphical data". Clearly, the claimed parser parses text data. Smiga teaches parsing user input text data and identify whether a keyword is associated with a person (Smiga, Fig. 2, element 3000, parser, col. 5, line 63 – col. 6, line 13, col. 23, lines 17-23). The parser of Smiga has the same functionality as the claimed parser. Therefore, the arguments are not persuasive.

11. As per applicant's arguments regarding the references do not teach automatically identifying at least one person represented by the identified data have been considered but are not persuasive. Smiga teaches automatically identifying at least one person represented by the identified data (Smiga, Fig. 2, element 3000, parser, col. 5, line 63 – col. 6, line 13, col. 23, lines 17-23, "the parser 300 of the present invention will automatically determined ... keyword 'Brian' will be recognized as a keyword linked to 'Brian Smiga' ..."). Therefore, the arguments are not persuasive.

12. As per applicant's arguments regarding Smiga reference finds keywords via parsing of a user entered text input which is not equivalent to parse an electronic document have been

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considered but are not persuasive. Because the claimed parser and the parser of Smiga both parse text data, and regardless whether the parser parses user entered text input or electronic document, their outcomes are the same. Therefore, the arguments are not persuasive.

13. As per applicant's arguments regarding the references do not teach changing the appearance of the parsed document have been considered but are not persuasive. Applicant argues that Smiga teaches a shadow region which is a separate display area from the user data entry region on a display device. Smiga teaches shadowing the keynote, and discloses the shadowing and modify the display is well known in the art (Smiga, Fig. 3, col. 6, lines 1-47). Since the system Smiga has the capability of shadowing the keynote, it could change the appearance of the identified data in the same display area or separate display area. Furthermore, the claim does not limit whether the modified appearance is displayed in same display area or different display area. Therefore, the arguments are not persuasive.

14. As per applicant's arguments regarding the references do not teach directly scan information that is being rendered on a computer display device have been considered but are not persuasive. The specification discloses the system interfaces with display rendering routines of a computer system and is capable scanning the display input (Specification, page 22-23, [0068]). Clearly, the scanner interfaces with the display rendering routines and scans the input of the display, it does not directly scan the display. Smiga teaches reading the user input text into a text buffer which is connect to a parser for parsing. The text buffer is connected to a display for displaying the text. Therefore, Smiga teaches scanning information that is input of the display. The arguments are not persuasive.

15. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Smiga by incorporating the means of searching and communicating as disclosed by Thorner. The motivation being to find additional information associated with the identified person such as email address so that the user can contact the identified person.

### *Conclusion*

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

*Contact Information*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chongshan Chen whose telephone number is (571) 272-4031. The examiner can normally be reached on Monday - Friday (8:00 am - 4:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chongshan Chen  
May 12, 2005

  
JEAN M. CORRIELUS  
PRIMARY EXAMINER